

PATENT

Atty. Dkt. No. CRU/0027 (formerly MRKS/0126)

REMARKS

This is intended as a full and complete response to the Final Office Action dated August 5, 2005, having a shortened statutory period for response set to expire on November 5, 2005. Please reconsider the claims pending in the application for reasons discussed below.

Claim Rejections – 35 U.S.C. § 102

Claims 2-5, 8, 11, 24-28 and 35-38 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,113,290 to *Miida*. In response, Applicants respectfully traverse the rejection.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Further, the elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Claim 2 has been amended to include the limitation of claim 7, which has not been rejected as being anticipated by *Miida*. Therefore, Applicants submit that *Miida* fails to anticipate claim 2 and claims 3-5, 8, 11 and 24-28 dependent thereon. Accordingly, Applicants respectfully request withdrawal of the rejection.

Claim 35 has been amended to include the limitation of claim 36, which states that "at least some of the gaps completely close when the thread portions move radially outward." However, the Examiner states that "the *Miida* coupling is not stated to be expanded." Thus, there cannot be any teaching in *Miida* of gaps that completely close when the thread portions move radially outward. This failure of *Miida* to teach each and every limitation in claim 35 precludes the reference from rendering claim 35 and claims 37 and 38 dependent thereon anticipated under § 102. Accordingly, Applicants respectfully request withdrawal of the rejection.

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Claims 2-5, 8, 11-14, 17, 21, 23-28 and 35-38 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,158,785 to *Beaulier et al.*

Claim 2 has been amended to include the limitation of claim 7, which has not been rejected as being anticipated by *Beaulier et al.* Therefore, Applicants submit that *Beaulier et al.* fails to anticipate claim 2 and claims 3-5, 8, 11 and 24-28 dependent thereon. Accordingly, Applicants respectfully request withdrawal of the rejection.

Claim 35 has been amended to include the limitation of claim 36, which states that "at least some of the gaps completely close when the thread portions move radially outward." However, the Examiner states that "the *Beaulier et al.* coupling is not stated to be expanded." Thus, there cannot be any teaching in *Beaulier et al.* of gaps that completely close when the thread portions move radially outward. This failure of *Beaulier et al.* to teach each and every limitation in claim 35 precludes the reference from rendering claim 35 and claims 37 and 38 dependent thereon anticipated under § 102. Accordingly, Applicants respectfully request withdrawal of the rejection.

Claim Rejections - 35 U.S.C. § 103

Claims 6, 7, 20 and 29-34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Miida* in view of WIPO application WO02/01102 and applicant's admitted prior art in the specification on pages 1-2. In response, Applicants respectfully traverse the rejection.

The Examiner states that it would have been obvious to expand the coupling of *Miida* as needed as taught by the WIPO application and applicants' disclosure in order to provide a more secure coupling. Further, the Examiner states that "to expand a member that is threaded is to eliminate gaps between thread flanks to provide a secured connection of two members." However, the Examiner does not cite any documentary evidence to support these conclusions. In fact, there is no indication in the references whether the gaps in the coupling disclosed in *Miida* would be eliminated, reduced, maintained or even increased by expansion of the coupling based on any relative different expansion that may occur within the coupling.

It is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record as the principal evidence upon which a rejection is

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based. In re Zurko, 258 F.3d 1379, 1385 (Fed. Cir., 2001); MPEP § 2144.04. Specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. Any facts, such as the Examiner's assertion relating expanding a member that is threaded to eliminate gaps between thread flanks to provide a secured connection, should be of a notorious character and serve only to "fill in the gaps" of peripheral issues in an insubstantial manner. However, the Examiner presently relies solely on this common knowledge assertion to satisfy a key element recited in the claims in order to make the obviousness rejection.

For the foregoing reasons, the factual assertion is (i) not properly officially noticed and (ii) not properly based upon common knowledge. Thus, the cited references, alone or in combination, fail to teach, show or suggest the claimed invention. Specifically, the references fail to teach, show or suggest that "once the thread portions are engaged and are subsequently expanded at least one of the gaps is closed and adjacent flanks are moved to close the at least one gap and to abut each other," as recited in claim 2 and previously in dependent claim 7. Further, the references fail to teach, show or suggest that "expanding the coupling includes securing the connection during expansion by abutting at least some of the remaining corresponding flanks," as recited in claim 29 and previously in dependent claim 33. Therefore, Applicants submit that claims 2 and 29 and all claims dependent thereon are allowable. Accordingly, Applicants respectfully request withdrawal of the rejection and allowance of the claims.

Claim 22 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Miida* in view of U.S. Patent No. 6,893,057 to *Evans*. Additionally, claim 22 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Beaulier* in view of *Evans*. In response, Applicants submit that claim 22 is allowable based at least on the traversal presented herein regarding claim 2, which claim 22 depends from. Accordingly, Applicants respectfully request withdrawal of the rejections and allowance of the claim.


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Conclusion

The references cited by the Examiner, alone or in combination, do not teach, show, or suggest the invention as claimed. Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted,



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